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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,605	03/20/2002	Jean-Marc Frances	022701-968	4221

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EXAMINER

BERMAN, SUSAN W

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/009,605	FRANCES ET AL.	
	Examiner	Art Unit	
	Susan W Berman	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) - | 6) <input type="checkbox"/> Other: _____ |

Specification

The abstract of the disclosure is objected to because the abstract is not printed on a separate page and includes additional text not part of the abstract. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 5, 6, 7 and 9 contain numerous extraneous symbols (such as *, -, [], →, □, +, •, etc.) that are not part of the claimed subject matter. Clean copies of these claims are required.

Claim 1, lines 8-11, the phrase "group consisting essentially of" must be followed by a list of members of the group ending with "and...". It is suggested that the lines read "group consisting essentially of at least one heterocyclic functional unit having one or more electron-donating atoms, at least one ethylenically unsaturated functional unit that is substituted by at least one electron-donating atom that enhances the basicity of the π system" and mixtures thereof"; lines 12-15, it is not clear what is meant by initiator salt "formed by" a "borate of an onium...or of an organometallic complex...". Does applicant intend to claim borate salts only or to claim an onium borate salt or an organometallic complex salt? Is the borate intended a reaction compound comprising a borate anion and an onium cation or an organometallic cation? If so, it should be so stated. There is no antecedent basis for the recitation in line 16 of "the cationic entity of said borate". Also, it is suggested that "onium salts" should be "onium cations". The phrase "onium salts" implies salts other than borate salts are included. See also, line 31 "oxoisothiochromanium salts", line 35 "sulfonium salts", line 91 "organometallic salts". In line 22, the phrase "it being possible for" renders the claims indefinite because it does not clearly recite whether or

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not R^1 comprises nitrogen or sulfur as heteroatoms. Line 49, "or" in the Markush group recited should be changed to "and". Line 58, it is suggested that the phrase "with the additional conditions according to which" be changed to read "with the proviso that". Line 61 the formula set forth is confusing because " Y^1 :" appears to be part of the formula. Line 76, the phrase "the possibility of being connected to..." renders the definition indefinite because it does not clearly state that the Ar^1 and Ar^2 radicals are optionally bonded to one another via Y^1 , etc.. Lines 79-80, it is suggested that the phrase "cited with respect to the definition of". Line 83 "and/or" should be changed to "and" to complete the Markush group recitation in line 16. Line 97, the first occurrence of "and" should be deleted in the recitation of the Markush group from lines 96-101. Lines 132-133, it is not clear what is intended by reactive diluents "consisting in" a nonorganosilicon, organosilicon or organic compound". Does applicant intend to set forth a Markush group, "selected from the group consisting of a nonorganosilicon compound, organosilicon compound and an organic compound"? It appears from the specification at pages 35-36, that applicant intends to set forth (1) organic compounds not containing silicon and (2) organosilicon compounds because applicant discloses "nonorganosilicon organic compounds" such as epoxies and vinyl ethers. There is no disclosure of nonorganosilicon compounds, such as tetramethylsilane, other than the organic compounds such as epoxies or vinyl ethers not containing silicon. Line 114, there is no antecedent basis for the recitation "the anionic entity borate". Lines 143-144, it is not clear whether applicant intends to claim applying the composition to a "support" or specifically to a "cylinder head gasket or a cylinder head/engine block interface".

Claim 4, line 7, the phrase "in that the functional units included in" is not clear. It is suggested that applicant delete "in that" or replace "in that" with "wherein".

Claim 5, there is no antecedent basis in claim 1 for "POSs A are epoxysilicones and/or vinyl ether silicones". Claim 1 recites "polyorganosiloxanes (POS)". It is suggested that applicant replace "epoxysilicones and/or vinyl ether silicones" with "wherein the CFGs in POSs A are epoxy and/or vinyl

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ether CFGs" or "wherein the POSs A are epoxy-functional polyorganosiloxanes and/or vinyl ether-functional polyorganosiloxanes".

Claim 6, there is no antecedent basis in claim 1 for "POSs A are epoxysilicones". Claim 1 recites "polyorganosiloxanes (POS)". See the discussion of claim 5 above. In the last line it is not clear whether applicant intends to set forth a third epoxy functional polysiloxane or to limit the compounds of formula (A.2) to an epoxidized disiloxane.

Claim 9, line 2, the recitation "adhesion promoter of the type of those comprising ..." renders the claim indefinite. It is not clear whether applicant intends to claim the compounds set forth or some other compounds similar to those set forth as the adhesion primers. The word "and" should be inserted in line 8 before "crosslinkable" to complete the Markush group begun in line 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2 757 870 in view of EP 0 522 703. FR '870 discloses a cylinder-head gasket coating method that includes employing a silicone composition containing a polyorganosiloxane and an initiator identical to those set forth in instant claim 1. FR '870 does not teach reactive diluents corresponding to component (C) of the compositions used in the instantly claimed method. EP '703 teaches the use of a reactive diluent for improving the performance of a bis(aryl)iodonium salt catalyst for epoxysilicone resins. The resins and catalysts disclosed are analogous to those taught by FR '870. EP '703 teaches that the reactive diluents provide improved miscibility of the catalyst and compositions having improved stability, improved hardening

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performance and improved anti-adherence. EP '703 does not disclose using the compositions for coating cylinder-head gaskets.

It would have been obvious to one skilled in the art at the time of the invention to employ the reactive diluent taught by EP '703 in the analogous compositions disclosed by FR '870 for improving the performance of the catalyst, as taught by EP '703. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of providing improved miscibility of the catalyst and compositions having improved stability, improved hardening performance and improved anti-adherence.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,423,378. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons. The instant claims include a process for impregnation of a coating on sheet gaskets as set forth in the claims of US '378 wherein the same initiator salts and the same polyorganosiloxanes are set forth in the instant claims and in the claims of US '378. The comprising language of the instantly claimed process encompasses the

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additional step of preimpregnation or precoating set forth in the claims of US '378. It would have been obvious to one skilled in the art at the time of the invention to employ the composition set forth in the claims of US '378 for impregnating a sheet gasket as set forth in the instant claims because the claims of US '378 recite carrying out impregnation on sheet gaskets with the composition set forth. One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of successfully impregnating a sheet gasket, as taught by the claims of US '378.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.



Susan W Berman
Primary Examiner
Art Unit 1711

SB
September 11, 2003